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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,467	11/26/2001	Bohdan Zajac	Prod Sol P-311	2698

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,467

Applicant(s)

ZAJAC, BOHDAN

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 15-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 16 recites that the coating composition comprises "a combination acrylic resin of a viscosity controller and a plasticizer". The scope of the claim is confusing because it is not clear what is meant by this phrase. Does this refer to an acrylic resin which functions both as a viscosity controller and a plasticizer? Clarification is requested.

(b) Claim 18, which depends on claim 16, recites coating composition "further comprising" plasticizer and viscosity controller. The scope of the claim is confusing since claim 16 already discloses the use of plasticizer and viscosity controller. Thus, it is not clear why the composition would further comprise these ingredients since plasticizer and viscosity controller are already present in the composition. Are the plasticizer and viscosity controller disclosed in claim 18 in addition to the plasticizer and viscosity controller disclosed in claim 16? Clarification is requested.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1714

5. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (U.S. 5,750,269) in view of Roberts (U.S. 5,453,459).

Park discloses water-washable coating composition for temporarily protecting a coating of paint on an article wherein the composition comprises film-forming acrylic resin having weight average molecular weight of 20,000-400,000 and acid number of 23-227. The composition comprises 5-50% solids with the remainder water wherein 10-80% of the solids is acrylic resin. Thus, it is calculated that the composition comprises 0.5-40% acrylic resin (col.1, lines 6-8, 45-50, and 55-67, col.4, lines 64-67, and col.5, lines 1-3, 7-8, and 25).

The difference between park and the present claimed invention is the requirement in the claims of caustic.

Park discloses the use of ammonia neutralizer.

Roberts, which is drawn to a temporary protective coating for automobiles, discloses the use of neutralizers including alkali metal hydroxides such as sodium hydroxide and potassium hydroxide in addition to ammonia. The alkali metal hydroxides are used in an amount of 0.5-10%. The motivation for using the alkali metal hydroxides is to adjust the pH of the coating composition (col.4, lines 15-19, 28-32, and 64).

In light of the motivation for using alkali metal hydroxide and given the disclosure by Roberts of the equivalence and interchangeability of ammonia, as disclosed by Park, with alkali metal hydroxide, it therefore would have been obvious to one of ordinary skill in the art to utilize alkali metal hydroxide in the coating composition of Park in order to produce a composition with the desired pH, and thereby arrive at the claimed invention.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler (U.S. 5,719,221) in view of Roberts (U.S. 5,453,459).

Swidler discloses a surface protective coating useful for protecting the surface of an automobile from scratches wherein the coating composition comprises water-soluble acrylic polymer which is polymerized from (meth)acrylic acid and other monomers, pH-neutral acrylic copolymer which is polymerized from monomers comprising (meth)acrylates, and water. The coating is removed by a water wash. There is also disclosed a method of protecting surfaces wherein the coating is applied to the surface to be protected including the exterior portions of an automobile (col.2, lines 8 and 50-54, col.3, lines 30-35, col.4, lines 10-13, col.5, lines 1, 8, 29-30, 35-38, 41, and 61-63, col.8, line 28, and col.9, lines 10 and 19).

The difference between Swidler and the present claimed invention is the requirement in the claims of caustic.

Swidler discloses the use of basic material such as ammonia and ethylamine to adjust the pH of the coating composition.

Roberts, which is drawn to a temporary protective coating for automobiles, discloses the use of alkali metal hydroxides such as sodium hydroxide and potassium hydroxide in addition to ammonia and ethylamine. The alkali metal hydroxides are used in an amount of 0.5-10%. The motivation for using the alkali metal hydroxides is to adjust the pH of the coating composition (col.4, lines 15-19, 28-32, and 64).

In light of the motivation for using alkali metal hydroxide and given the disclosure by Roberts of the equivalence and interchangeability of ammonia and ethylamine, as disclosed by Swidler, with alkali metal hydroxide, it therefore would have been obvious to one of ordinary

skill in the art to utilize alkali metal hydroxide in the coating composition of Swidler in order to produce a composition with the desired pH, and thereby arrive at the claimed invention.

Allowable Subject Matter

7. Claim 19 is allowed over the "closest" prior art for the following reasons.

Swidler (U.S. 5,719,221) discloses a surface protective coating useful for protecting the surface of an automobile from scratches wherein the coating composition comprises 1-10% water-soluble acrylic polymer which is polymerized from (meth)acrylic acid and other monomers, (2) 1-10% pH-neutral acrylic copolymer which is polymerized from monomers comprising (meth)acrylates, (3) 0.2-1% surfactant and/or wetting agent, (4) thickener, and (5) substantial amount of water wherein the balance of the composition is water. The coating has a pH of 7-9. However, there is no disclosure or suggestion in Swidler of caustic as presently claimed as well as no disclosure of the molecular weight of the acrylic resins, viscosity of the composition, or acid number of the composition as required in claim 19.

Park (U.S. 5,750,269) discloses water-washable coating composition for temporarily protecting a coating of paint on an article wherein the composition comprises film-forming acrylic resin having weight average molecular weight of 20,000-400,000 and acid number of 23-227. The composition comprises 5-50% solids with the remainder water wherein 10-80% of the solids is acrylic resin. However, there is no disclosure or suggestion of using two acrylic resins or caustic as presently claimed. Further, there is no disclosure of pH or viscosity of the composition as required in claim 19.

Roberts (U.S. 5,453,459) disclose a temporary protective coating composition for automobiles which comprises caustic such as alkali metal hydroxide, water, and mixture of acrylic acid copolymers. However, there is no disclosure in Roberts of the molecular weight of either of the acrylic resins as presently claimed. Further, there is no disclosure of acid number, pH, or viscosity of the composition as required in claim 19.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maxwell et al. (U.S. 6,011,107) disclose a water washable protective coating composition comprising mixture of two acrylic polymers and caustic, however, given the effective filing date, this reference cannot be used as prior art under any subsection of 35 USC 102.

Grogan et al. (U.S. 5,143,949) disclose an aqueous based strippable coating composition. However, the composition does not contain combination of acrylic resins or caustic as presently claimed. Further, there is no disclosure of acid number, pH, or viscosity of the composition.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Application Number: 09/996,467

Page 8

Art Unit: 1714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS

July 21, 2003